UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SONYA S. JOHNSON, DAVID G. BARKALOW, MICHAEL J. GREENBERG and GLORIA T. SHELDON

Appeal No. 2006-0070
Application No. 10/024,631

HEARD: JANUARY 25, 2006

Before PAK, WARREN and TIMM, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 22 and 25 through 38, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

BACKGROUND

The subject matter on appeal relates to a coated chewing gum having a gum base or center containing, inter alia, a bicarbonate salt and a coating containing at least one medicament and either xylitol or sorbitol. See the specification, pages 4 and 5. This

coated chewing gum is said to provide enhanced absorption of the medicament through oral mucosa. See the specification, page 5. Details of the appealed subject matter are recited in representative claims 1, 16, 30 and 38, which are reproduced below.

1. A coated chewing gum product with absorption acceleration of a medicament, comprising:

a) a chewing gum center comprising a gum base, a flavor, and a bulking/sweetening agent;

b) a chewing gum coating comprising a polyol selected from the group consisting of xylitol and sorbitol, and containing at least one medicament; and

c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

16. A coated chewing gum product including a medicament comprising:

a) a chewing gum center;

b) a chewing gum coating containing at least one medicament and a polyol selected from the group consisting of xylitol and sorbitol; and

c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

30. A method of delivering a medicament with accelerated absorption through the oral mucosa comprising the steps of:

a) providing a chewing gum center;

b) coating the chewing gum center with a coating comprising a polyol selected from the group consisting of xylitol and sorbitol, and containing at least one medicament;

c) either the chewing gum center, the coating, or both incorporating a bicarbonate salt; and

d) causing an individual in need of the medicament to chew the product.

38. A coated chewing gum product with absorption acceleration of caffeine, comprising;

a) a chewing gum center comprising a gum base, a flavor, and a bulking/sweetening agent;

b) a chewing gum coating comprising caffeine and a polyol selected from the group consisting of sorbitol and xylitol; and

c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hill	5,380,530	Jan. 10, 1995
Andersen et al. (Andersen)	5,487,902	Jan. 30, 1996
Gudas et al. (Gudas) (Published International Patent Application)	WO 98/23165	Jun. 4, 1998

Claims 1 through 22, 25 through 27, 30 through 34 and 37 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hill. See the Office action dated July 29, 2004, page 2 and the Answer, page 3. Claims 28, 29, 35, 36 and 38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hill, Andersen and Gudas. See the Office action dated July 29, 2004, pages 3 and 4 and the Answer, page 3.

OPINION

For the reasons set forth below, we reverse the examiner's § 102(b) rejection and remand the application to the examiner for appropriate action.

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), the applied prior art reference must clearly and unequivocally disclose all of the elements of the claims on appeal, "without any need for picking, choosing, and combining various disclosures" therein. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Here, the prior art reference, Hill, relied upon by the examiner teaches a chewing gum comprising a gum base containing a flavoring agent and a sweetening/bulking agent coated with an emulsion coating containing one or more therapeutic substances. See column 15, lines 12-19 and column 18, line 10 to column 19, line 31. Hill then goes on to state (column 16, lines 6-13) that:

> Other substances which may also be included in the chewing gum base mixture and which **may also be added** to the emulsion coating include: non toxic sources for acid such as adipic acid in combination with **calcined kaolin**[1], calcium carbonate, sodium carbonate, sodium bicarbonate, **various phosphates**, dicalcium phosphate,

[1] The terms "kaolin", "hydrolyzable tannin" and "various phosphates" include many clays, tannin compounds and phosphates.

> tetra sodium pyrophosphate, lecithin, lanolin, **hydrolyzable tannin**, silica, and **the like**. (Emphasis added.)

Hill further states (column 17, lines 1-11 and 56-59) that:

> The high flavor levels which can be pleasantly incorporated into emulsion coatings of this invention...For example, natural and synthetic flavor and sweetener agents as diverse as menthol, xylitol and glycyrrhizin are known to be beneficial towards plaque control...
> ...
> In addition to the buffering ingredients, the [emulsion coating] compositions of the invention can **optionally contain at least one** humectant selected from the group consisting of glycerine, xylitol, sorbitol and propylene glycol.

To arrive at the invention recited in the claims on appeal, one of ordinary skill in the art would have to pick and choose from a relatively broad disclosure of a large number of optional substances. Such picking and choosing has no place in making a Section 102 rejection for anticipation. Arkley, 455 F.2d at 587-88, 172 USPQ at 526; In re Schaumann, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978). Accordingly, we reverse the examiner's rejection of claims 1 through 22, 25 through 27, 30 through 34 and 37 under 35 U.S.C. § 102(b).

REMAND

Although some picking and choosing may have no place in making a Section 102 rejection, it may be entirely proper in making an obviousness rejection under Section 103. Arkley, 455

F.2d at 587-88, 172 USPQ at 526. The fact that Hill "discloses a multitude of effective combinations does not render any particular formulation less obvious." Merck & Co. Inc. v. Biocraft Labs. Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). Thus, based on the fact findings set forth above and in the Answer, we determine that Hill would have rendered the subject matter defined by claims 1 through 22, 25 through 27, 30 through 34 and 37 prima facie obvious within the meaning of 35 U.S.C. § 103(a).

The examiner has also determined that the combined disclosures of Hill, Andersen and Gudas would have rendered the subject matter defined by claims 28, 29, 35, 36 and 38 prima facie obvious within the meaning of 35 U.S.C. § 103(a). However, as is apparent from the Answer, the examiner has not addressed, inter alia, the rebuttal evidence relied upon by the appellants at page 7 the Reply Brief. According to the appellants (Reply Brief, page 7), the test results on pages 25 through 31 of the specification demonstrate that the claimed subject matter imparts unexpected results, thereby rebutting any prima facie case of obviousness established by the examiner.

It is well established that if a prima facie case is made in the first instance, and if the appellants come forward with

reasonable rebuttal, e.g., experiment evidence, the entire merits of the matter are to be reweighed. In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). In order to properly weigh the evidence of record, the examiner must determine whether the appellants have demonstrated that the test results relied upon are truly unexpected and are commensurate in scope with the degree of protection sought by the claims on appeal. In re Merck & Co., 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). However, the examiner has done neither in this case. See the Answer in its entirety. Accordingly, we cannot ascertain the propriety of the examiner's Section 103(a) rejection of claims 28, 29, 35, 36 and 38 based on Hill, Andersen and Gudas and the appropriateness of any new Section 103(a) rejection against claims 1 through 22, 25 through 27, 30 through 34 and 37 based on the teachings of Hill.

Thus, we return this application to the examiner to review the test data at pages 25 through 31 of the specification to determine whether the test results in question are sufficient to rebut any prima facie case of obviousness of the subject matter defined by all of the claims on appeal. If they do not meet the

requirements set forth in Klosak, Merck & Co., and Grasselli, respectively, as indicated supra, the examiner is to set forth a new ground of rejection against claims 1 through 22, 25 through 27, 30 through 34 and 37 under Section 103(a) and explain insufficiencies of the test results relied upon by the appellants pursuant to 37 CFR 41.50(a) and (b)(2004).

CONCLUSION

For the foregoing reasons, we reverse the examiner's decision rejecting claims 1 through 22, 25 through 27, 30 through 34 and 37 under 35 U.S.C. § 102, and remand the application to the examiner for appropriate action in view of our comments above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status requires an immediate action. Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED-IN-PART/REMANDED

CHUNG K. PAK)
Administrative Patent Judge)
)
)
)
) BOARD OF PATENT
CHARLES F. WARREN) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
)
CATHERINE TIMM)
Administrative Patent Judge)

CKP:rwk

WRIGLEY & DREYFUS 28455
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610